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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/720,952

11/24/2003

Craig L. Reding

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EXAMINER

ELAHEE, MD S

ART UNIT

PAPER NUMBER

2614

NOTIFICATION DATE

DELIVERY MODE

11/13/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@verizon.com

Office Action Summary	Application No.		Applicant(s)	
	10/720,952		REDING ET AL.	
	Examiner		Art Unit	
	MD S. ELAHEE		2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/09/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 07/06/2009. Claims 1-14 and 19-26 are pending. Claims 15-18 have been added.

Response to Arguments

2. Applicant's arguments filed in 07/06/2009 remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

5. Claim 26 recites a computer-readable medium comprising instructions. Claim language does not comply with the requirements of MPEP 2106.01.I. The “medium” is only recited once in the invention disclosure (Preamble of Claim 26). Since “medium” is not defined in the disclosure, it may encompass a variety of media ranging from a piece of paper to a carrier signal. Furthermore, “computer program” or “software” is merely a set of instructions. On the contrary, “memory”, “computer program” and “software” are well defined acceptable terminology in computer programming. Additionally, comprising is not an acceptable linking word to associate “computer readable medium” to a “computer program product”. Computer program is data structure. The claimed instructions are merely data structure. Data structures not claimed as embodied in computer-readable or machine-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer or machine. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Claim 26 fails to include practical application that produces either (1) tangible, concrete and useful result or (2) physical transformation. Therefore, since the claimed computer-readable medium does not comprise instructions to cause a processor to perform the storing, receiving, converting and transmitting functions of the claim then the Applicant has not complied with 35 U.S.C 101.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-12 of co-pending application no. 10/720,920. Because claim in the pending application is broader than the one in co-pending application, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 1 of the pending application are the same as claim 1 of the co-pending application except receiving a notification at a server.

8. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 and 110 of co-pending application no. 10/858,973. Because claim in the pending application is broader than the one in co-pending application, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 1 of the pending application are the same as claim 1 of the co-pending application except displaying step.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-14 and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abburi (U.S. Patent No. 7,130,390) in view of Chin (U.S. Patent No. 5,661,788).

Regarding claims 1, 12, 19, 26, with respect to Figures 1, 2 and 4, Abburi teaches a method comprising:

receiving incoming call data indicating an incoming call directed to one of the plurality of devices associated with the user from a calling device associated with a caller, the incoming call data being in a format for the calling device (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.6, lines 24-41); and

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Abburi further teaches transmitting/generating the notification to the user's preferred device (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.6, lines 24-41).

However, Abburi does not specifically teach storing data reflecting a preferred device upon which a user prefers to receive notifications of incoming calls, the preferred device being one of a plurality of devices associated with the user. Chin teaches storing data reflecting a preferred device upon which a user prefers to receive notifications of incoming calls, the preferred device being one of a plurality of devices associated with the user (fig.2, steps 2i, 2j; col.2, lines 1-21). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Abburi to incorporate the feature of storing data reflecting a preferred device upon which a user prefers to receive notifications of incoming calls, the preferred device being one of a plurality of devices associated with the user in Abburi's invention as taught by Chin. The motivation for the modification is to do so in order to provide notification based on choice of a user such that the user can easily be informed important message from a specified phone number.

Abburi in view of Chin further does not specifically teach converting the incoming call data from the data format for the calling device into a data format for the preferred device. Examiner notes that converting the incoming call data from the data format for the calling device into a data format for the preferred device is well known in the art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Abburi in view of Chin to incorporate the feature of converting the incoming call data from the data format for the calling device into a data format for the preferred device in Abburi's invention in view of

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Chin's invention in order to provide incoming messages based on type of a user device such that the user can easily be informed important message from a particular person of the incoming message in different format.

Regarding claim 2, Abburi, as applied to claim 1, teaches receiving user selection of the preferred device (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.6, lines 24-41).

Regarding claim 3, Abburi, as applied to claim 1, teaches that receiving a user selection of a time period during which notifications are to be transmitted to the preferred device (col.5, lines 45-61).

Regarding claim 4, Abburi, as applied to claim 1, teaches that receiving a user selection of a device for which notifications are to be transmitted to the preferred device (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62).

Regarding claims 5 and 20, Abburi, as applied to claims 1 and 19, does not specifically teach receiving a user selection of calling parties from which notifications are to be transmitted to the preferred device. Chin teaches receiving a user selection of calling parties from which notifications are to be transmitted to the preferred device (fig.2, steps 2i, 2j; col.2, lines 1-21). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Abburi in view of Major to incorporate the feature of receiving a user selection

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of calling parties from which notifications are to be transmitted to the preferred device in Abburi's invention as taught by Chin. The motivation for the modification is to do so in order to filter incoming messages based on choice such that the user can easily informed important messages from a particular person.

Claims 6 and 21 are rejected for the same reasons as discussed above with respect to claims 5 and 17.

Regarding claim 7, Abburi, as applied to claim 1, teaches receiving user specifications for receiving notifications by a preferred device based on at least one of the time of day or calling party (col.5, lines 45-61).

Regarding claim 8, Abburi, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a wireless phone capable of displaying text messages (col.4, lines 35-62, col.8, lines 48-54).

Regarding claim 9, Abburi, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a landline phone (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62).

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Regarding claim 10, Abburi, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a desktop or laptop computer (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62).

Regarding claim 11, Abburi, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a handheld device (col.4, lines 35-62, col.8, lines 48-54).

Regarding claim 13, Abburi, as applied to claim 12, teaches that a database for storing identifications of calling parties from whom notifications are transmitted to the preferred device (col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.10, line 12-col.11, line 3).

Regarding claim 14, Abburi, as applied to claim 13, teaches that the database stores times during which notifications are transmitted to the preferred device (col.5, lines 45-61).

Regarding claim 22, Abburi, as applied to claim 1, does not specifically teach blocking the notification to the preferred device when the incoming data is from a phone number other than one or more phone numbers specified by the user in advance of receiving the incoming call. Chin teaches blocking the notification to the preferred device when the incoming data is from a phone number other than one or more phone numbers specified by the user in advance of receiving the incoming call (fig.2, steps 2k; col.4, lines 63-67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify

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Abburi in view of Major to incorporate the feature of blocking the notification to the preferred device when the incoming data is from a phone number other than one or more phone numbers specified by the user in advance of receiving the incoming call in Abburi's invention as taught by Chin. The motivation for the modification is to do so in order to filter incoming notification based on choice such that the user can easily informed important notification from a particular person.

Regarding claims 23 and 24, Abburi in view of Chin does not specifically teach that the user's preferred device is a phone/an instant message client, and the incoming call data is converted into a text message notification/an instant message notification of the incoming call. Examiner notes that the user's preferred device as a phone/an instant message client, and the incoming call data being converted into a text message notification/an instant message notification of the incoming call is well known in the art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Abburi in view of Chin to incorporate the feature of the user's preferred device as a phone/an instant message client, and the incoming call data being converted into a text message notification/an instant message notification of the incoming call in Abburi's invention in view of Chin's invention in order to provide incoming messages based on type of a user device such that the user can easily be informed important message from a particular person of the incoming message in different format.

Regarding claim 25, Abburi, as applied to claim 1, does not specifically teach that the incoming call is directed to one of the plurality of devices other than the preferred device. Chin teaches that the incoming call is directed to one of the plurality of devices other than the preferred device (fig.2, steps 2k; col.4, lines 63-67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Abburi in view of Major to incorporate the feature of directing the incoming call to one of the plurality of devices other than the preferred device in Abburi's invention as taught by Chin. The motivation for the modification is to do so in order to filter incoming notification based on choice such that the user can easily informed important notification from a particular person.

12. Claims 1, 12, 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huna et al. (U.S. Pub. No. 2001/0012286) in view of Abburi (U.S. Patent No. 7,130,390) further in view of Chin (U.S. Patent No. 5,661,788).

Regarding claims 1, 12, 19, 26, with respect to Figures 1-3, 6, 8 and 11-14, Huna teaches a method comprising:

receiving incoming call data indicating an incoming call directed to one of the plurality of devices associated with the user from a calling device associated with a caller, the incoming call data being in a format for the calling device (abstract; page 2, paragraphs 0016-0020, page 3, paragraphs 0042, 0043, page 4, paragraph 0047, page 6, paragraphs 0070-0072, page 7, paragraphs 0084, 0086, 0087);

Huna further teaches transmitting the notification to the user's preferred device (abstract; page 2, paragraphs 0016-0020, page 3, paragraphs 0042, 0043, page 4, paragraph 0047, page 6, paragraphs 0070-0072, page 7, paragraphs 0084, 0086, 0087); and

Huna further teaches converting the incoming call data from the data format for the calling device into a data format for the preferred device to generate a notification of the incoming call (abstract; page 3, paragraphs 0042, 0043, page 4, paragraph 0047, page 6, paragraphs 0070-0072).

Huna further teaches that receiving alert depend on user's choice of type of device he desires to receive the alert (page 7, paragraph 0092). However, Huna does not specifically teach a telephone user having a plurality of devices. Abburi teaches a telephone user having a plurality of devices (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.6, lines 24-41). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Huna to incorporate a telephone user having a plurality of devices in Huna's invention as taught by Abburi. The motivation for the modification is to do so in order to receive notification messages in different types of user devices such that the user can receive notification whenever he is with a particular type of device at his own choice.

Huna in view of Abburi does not specifically teach storing data reflecting a preferred device upon which a user prefers to receive notifications of incoming calls, the preferred device being one of a plurality of devices associated with the user. Chin teaches storing data reflecting a preferred device upon which a user prefers to receive notifications of incoming calls, the preferred device being one of a plurality of devices associated with the user (fig.2, steps 2i, 2j; col.2, lines 1-21). Thus, it would have been obvious to one of ordinary skill in the art at the time

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the invention was made to modify Huna in view of Abburi to incorporate the feature of storing data reflecting a preferred device upon which a user prefers to receive notifications of incoming calls, the preferred device being one of a plurality of devices associated with the user in Huna's invention in view of Abburi's invention as taught by Chin. The motivation for the modification is to do so in order to provide notification based on choice of a user such that the user can easily be informed important message from a specified phone number.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on MON-FRI.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, FAN TSANG can be reached on (571)272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MD S ELAHEE/
MD SHAFIUL ALAM ELAHEE
Primary Examiner
Art Unit 2614
November 10, 2009